

REMARKS

Favorable reconsideration of this application in light of the preceding amendments and the following remarks is respectfully requested.

No claims having been canceled and claims 18-20 having been added, the Applicants respectfully submit that claims 1-20 remain pending in this application with claims 8-17 having been withdrawn from consideration as directed to a non-elected invention and claims 1-7 and 18-20 remaining properly under consideration in this application with claims 1 and 18 being written in independent form.

Support for the new claims 18-20 may be found in at least original claim 1, FIGS. 4, 5 and 9 and the corresponding portions of the Specification at, for example, pages 9-10, paragraphs [0038]-[0046].

The Applicants note with appreciation the Examiner's acknowledgement that the original Drawings received on July 18, 2003, are accepted.

The Applicants also note with appreciation the Examiner's recognition of the Applicants' claim for priority under 35 U.S.C. § 119. The Applicants respectfully contend, however, that contrary to the indication provided in item 12 of the Office Action Summary, that certified copies of the three priority documents were filed in the United States Patent and Trademark Office ("USPTO") on August 7, 2003. The Applicants respectfully contend, therefore, that the USPTO has received certified copies of the priority documents (as indicated by the attached stamped receipt) and would appreciate the Examiner's investigation into this discrepancy and confirmation in the next Office Action of the USPTO's receipt of a certified copy of each of the three priority documents.

Restriction Requirement

The Examiner has imposed a restriction between two inventions corresponding to designated groupings of the claims. Action at 2. As defined by the Examiner, the two inventions are:

Group I, claims 1-7, drawn to a film carrier tape, classified in Class 248 and subclass 209; and

Group II, claims 8-17, drawn to a method of manufacturing a film carrier tape, classified in Class 156, subclass 193.

Election of Species

Further to the discussion between the Examiner and the undersigned on September 10, 2004, the Applicants elect, with traverse, the Group I claims, specifically claims 1-7 for prosecution in this application.

Arguments in Support of Traversal

The Examiner correctly notes that these two groups of claims are related as a process of making and the product made by the recited process. The Examiner further contends that the product, as claimed, may be made with another and materially different process “such by laminating and punching holes” and that the process “as claimed can be used to make a different product such as a decorative art work.” Action at 2. The Applicants respectfully contend that the Examiner’s “materially different” process merely recites alternative terms for two of the recited methods steps, *e.g.*, “laminating” for

“attaching a raw film to a base film” and “punching holes” for forming a plurality of sprocket holes through ... the base film and the raw film,” and has not, therefore, adequately supported the alleged “material differences.” Similarly, the Applicants respectfully contend that film carrier tapes may be considered works of art and that no adequate basis has been provided for distinguishing the reference to a “film carrier tape” in the preamble and a “decorative art work” that includes each of the recited structures formed by the recited steps.

The Applicants also respectfully contend that the intimate relationship between the steps in a method of manufacturing and the structure or device resulting from the recited combination of method steps necessitates significant overlap in the prior art search directed to either of the defined groups of claims. The Applicants respectfully note that, in order for a restriction to be proper, the inventions must be independent or distinct as claims *and* there must be a serious burden on the examiner. MPEP § 803. The Applicants respectfully contend that in this instance, notwithstanding the different classification of the two inventions, the degree to which the prior art relevant to the two inventions overlaps is sufficient to overcome the prima facie presumption of undue burden. The Applicants respectfully maintain, therefore, that these two inventions, although independent and distinct, should not be subjected to a restriction requirement.

Correction of Inventorship

The Applicants acknowledge their obligation to ensure that the indicated inventors are properly included with respect to the claims that have been elected for

prosecution and respectfully maintain that no correction is necessitated by the present election.

Objections to the Specification

The Specification stands objected to for a typographical error noted in paragraph [0050]. The Applicants respectfully submit that the amendment above to paragraph [0050] is sufficient to overcome this objection and respectfully request that it be withdrawn.

Objection to the Drawings

The Examiner has noted that reference numeral 112 included in FIG. 1 is not reflected in the Specification text. The Applicants respectfully contend that the amendment to paragraph [0004] reflected above is sufficient to correct this oversight and, as it generally parallels the construction and numbering illustrated in FIG. 4 but is intended to illustrate only the conventional art, does not constitute the introduction of new matter.

Request for Information Disclosure Statement

The Examiner has requested that the Applicants submit “any prior art they are aware of with they believe would be helpful to the Examiner....” Action at 3. The

Applicants acknowledge their obligations under 37 C.F.R. § 1.56 and will continue to meet those obligations during the prosecution of this application.

Rejections Under 35 U.S.C. § 112

Claim 4 stands rejected under 35 U.S.C. § 112, second paragraph, as indefinite due to a lack of antecedent basis for the claim term “synthetic resin.” Action at 3. The Applicants respectfully maintain that the amendment to claim 4 reflected above, which simply changes the dependency of claim 4 from claim 1 to claim 3, which provides the necessary antecedent basis, is sufficient to overcome this rejection and request, therefore, that it be withdrawn.

Rejections Under 35 U.S.C. § 102

Claim 1 stands rejected under 35 U.S.C. § 102(b) as anticipated by Yamazaki’s U.S. Patent No. 5,345,039 (“Yamazaki”). The Applicants respectfully traverse this rejection for the reasons detailed below.

The Applicants respectfully note that the reinforcing layer taught by Yamazaki is a copper foil. Col. 2, lines 56-60. The Applicants also respectfully submit that those of ordinary skill in the art would not consider a copper foil to be “an insulating second material” as recited in claim 1. Indeed, the Applicants note that such constructions are discussed in connection with the conventional art upon which the present invention improves. The Applicants respectfully contend, therefore, that Yamazaki does not recite,

teach or suggest each of the elements arranged in the manner recited in claim 1 and cannot, therefore, anticipate this claim.

The Applicants, therefore, respectfully request that this rejection be withdrawn.

Claims 1-7 stand rejected under 35 U.S.C. § 102(b) as anticipated by Saito's U.S. Patent No. 6,320,135 B1 ("Saito"). Action at 4-5. The Applicants respectfully traverse this rejection for the reasons detailed below.

The Applicants respectfully note that patent claims are to be interpreted in light of the specification and patent figures that support the claims. The Applicants, therefore, respectfully contend that when the original claims are considered in light of FIGS. 4-9 and the associated text, it would be obvious to one of ordinary skill in the art that the invention is directed to film carrier tapes in which the reinforcing layer is provided only on the periphery area of the base film. The Applicants also respectfully note that the "removing a central portion of the raw film" step recited in claim 8, particularly when considered in light of the "reinforcement film being provided on the peripheral area of the base film" limitation as recited in claim 1, are incompatible with a final film carrier tape in which the reinforcing film remains on the entire main region.

The Applicants respectfully note, however, that Saito teaches a reinforcing film 104 that covers both the "peripheral" and "main" regions of the disclosed film carrier tape and does not teach or suggest removing that portion of the reinforcing film that is in the main area of the base film. The Applicants respectfully contend, therefore, that Saito

does not recite, teach or suggest each of the elements arranged in the manner recited in claims 1-7 and cannot, therefore, anticipate these claims.

The Applicants, therefore, respectfully request that this rejection be withdrawn.

New Claims 18-20

The Applicants respectfully submit that new claims 18-20 may be found in at least original claims 1-3, FIGS. 4, 5 and 9 and the corresponding portions of the Specification at, for example, pages 9-10, paragraphs [0038]-[0046]. The Applicants respectfully note that new claim 18 simply makes more explicit the relationship between the reinforcement film and the main area of the film carrier tape noted above in the discussion of claim 1. The Applicants also contend that these new claims do not constitute the introduction of new matter and are sufficiently consistent with the scope of the original claims 1-7 to be encompassed by substantially the same prior art search.

CONCLUSION

In view of the above remarks and amendments, the Applicants respectfully submit that each of the pending objections and rejections have been addressed and overcome, leaving the present application in condition for allowance. A notice to that effect is respectfully requested.

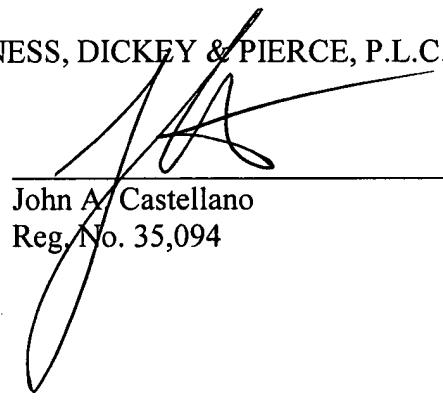
If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to contact the undersigned by telephone at (703) 668-8000.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge any underpayment or non-payment of any fees required under 37 C.F.R. §§ 1.16 or 1.17, or credit any overpayment of such fees, to Deposit Account No. 08-0750, including, in particular, extension of time fees.

Respectfully submitted,

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